

### **REMARKS**

In view of the above amendments and the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow 7-26 and 44-49, as well as newly added claims 50 and 51, the only claims pending and currently under examination in this application.

#### **Amendment to the Inventorship**

Applicants hereby request to add Charles Z. Hotz as an inventor, pursuant to 37 C.F.R. § 1.48(c). Amendments introduced above which include claims to previously unclaimed subject matter necessitate this amendment to the inventorship. Enclosed with this response are the requisite: (1) statement by Charles Z. Hotz; (2) new Oath or Declaration including all of the inventors' signatures; (3) processing fee pursuant to 37 C.F.R. § 1.17(i); and (4) written consent by the assignee of the originally named inventors in the form of the enclosed statement pursuant to 3.73(b).

#### **Amendment to the Specification**

Applicants have amended the specification to make a claim to priority to the filing date of U.S. Patent Application serial no. 09/145,015, pursuant to 37 C.F.R. § 1.78(a)(3). The entire delay between the date the claim was due under paragraph 37 C.F.R. § 1.78(a)(2)(ii) and the present request was unintentional. Enclosed with this response is the requisite: (1) processing fee pursuant to 37 C.F.R. § 1.17(t).

#### **Amendment to the Claims**

All of the claims have been amended to specify that the olefin displaying surface of the substrate is produced by contacting the surface with an olefin-silane derivatizing composition, support for this amendment being found in the specification in paragraphs 40 to 46, among other locations. New claims 50 and 51 find support in the specification specifically at page 19, paragraph 71. As each of the above

amendments finds full support in the specification as originally filed and therefore introduces no new matter, entry of each of the above amendments is respectfully requested.

### **Rejection of Claims under 35 U.S.C. § 103**

Claims 7-14, 16-23, 25-26 and 44-49 remain rejected under 35 U.S.C. § 103(a) as being obvious over Sundberg in view of Wang, for the asserted reason that the combined teachings of these references teach a method of producing a ligand array by attaching ligands to a functionalized surface, which combined teaching assertedly renders the claimed invention obvious.

However, a feature of the pending claims is that the substrate which is contacted with the ligands in the claimed methods is one that is provided by **"contacting said surface with a derivatizing composition comprising at least a first silane having an olefin functional group..."** As such, the claimed methods are limited in that the surface of the substrate employed in the claimed methods must be produced by contacting the substrate surface with a derivatizing composition that includes a silanating agent having an olefinic functional group, i.e., a functional groups that includes a carbon-carbon double bond.

Both Sundberg and Wang describe functionalized surfaces in general, but fail to teach or suggest such a surface-derivatizing step, as required in the claims.

As such, the combined teaching of Sundberg and Wang fails to teach or suggest the claimed methods. Accordingly, Claims 7-14, 16-23, 25-26 and 44-47 are not obvious under 35 U.S.C. § 103(a) over Sundberg in view of Wang and this rejection may be withdrawn.

Next, Claims 7, 15-16 and 24 are rejected under 35 U.S.C. § 103(a) as being obvious over Sundberg in view of Wang, and further in view of Gleason.

As explained above, a feature of the pending claims is that the substrate which is contacted with the ligands in the claimed methods is one that that is provided by **"contacting said surface with a derivatizing composition comprising at least a first silane having an olefin functional group..."** As such, the claimed methods are limited in that the surface of the substrate employed in the claimed methods must be produced by contacting the substrate surface with a derivatizing composition that includes a silanating agent having an olefinic functional group, i.e., a functional groups that includes a carbon-carbon double bond.

Both Sundberg and Wang describe functionalized surfaces in general, but fail to teach or suggest such a surface-derivatizing step, as required in the claims. Gleason also fails to teach or suggest such a surface derivatizing step, as required in the claims, as required in the claims.

As such, the combined teaching of Sundberg and Wang in view of Gleeson fails to teach or suggest the claimed methods. Accordingly, Claims 15-16 and 24 are not obvious under 35 U.S.C. § 103(a) over Sundberg in view of Wang and further in view of Gleeson and this rejection may be withdrawn.

**CONCLUSION**

The applicant respectfully submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Gordon Stewart at 650 485 2386. The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-1078.

Respectfully submitted,

Date: October 2, 2003

By: 

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encs:

- Statement by Charles Z. Hotz
- New Declaration by Inventors (partially completed)
- Processing fee pursuant to 1.17(h)
- Statement Under 3.73(b)